

REMARKS

It is initially noted that upon review of Applicant's prior Response dated November 30, 2007, an inadvertent error was noted in the amendments made to the claims. In particular, the amendments were not made to the version of claims currently pending (substitute specification claims), but rather to the claims as presented in the PCT application. Applicant apologizes for this inadvertent error. Accordingly, claims 1-8 are canceled without prejudice and rewritten as new claims 18-25, which reflect the proper wording. Claim 9, which previously depended from claim 1, also has been clarified to improve upon the wording and now depends from claim 18. It is noted that the foregoing amendments and cancellations are not made for reasons related to patentability and the full range of equivalents should remain in tact.

Upon entry of this Response, claims 9-15 and 17-25 are pending. Of those claims, claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable in rewritten in independent form including the limitations of the base claim and any intervening claims. Applicant thanks the Patent Office for this indication of allowable subject matter.

Regarding the remaining claims, claims 16-17 are rejected under 35 USC Section 101 as being directed to non-statutory subject matter. These claims also are rejected under 35 USC Section 112, first paragraph, as failing to comply with the written description requirement.

Applicant respectfully disagrees with the above rejections. However, in the interest of advancing the prosecution of the subject application, claims 16-17 are cancelled. Accordingly, the above rejections should be reconsidered and withdrawn.

Claims 1-8 are then rejected under 35 USC Section 112, second paragraph, as being indefinite. In particular, the Patent Office contends that it is unclear whether line 8 of claim 1 refers to a single spare bit or to one or more spare bits.

Applicant respectfully asserts that the pending claims in the subject application are definite.

However, in the interest of advancing prosecution, new claim 18 recites, in part, that “the method comprises using of said at least one spare bit ...” Accordingly, the foregoing rejection should be reconsidered and withdrawn.

Regarding the rejections based upon art, claims 1, 2, 8-13 and 15 are rejected under 35 USC Section 103(a) as being unpatentable over Mildh et al. (US Patent Publication 2002/0193139 A1) in view of “Applicant’s description of the prior art.” In particular, the Patent Office refers to paragraph 6 of Applicant’s specification as “Applicant’s description of the prior art.” Lastly, dependent claims 3-6 and prior claims 16-17 are rejected under 35 USC Section 103(a) as being unpatentable over Mildh et al. (US 2002/0192139 A1) in view of “Applicant’s description of the prior art” and further in view of ETSI 3GPP 04.18 v 9.0.

The foregoing rejections are respectfully disagreed with, and are traversed below.

Regarding the Patent Office’s characterization of the teachings of Mildh et al., it is respectfully asserted that this analysis is not correct. Thus, Applicant respectfully asks the Patent Office to reconsider the rejections based on Mildh et al. in view of the following comments.

On page 4 of the Action, it is contended that Mildh et al. disclose:

“... whether said cell supports an UMTS service (paragraph 16, 21), and in a favourable case in which the GERAN controlled cell is determined to support the UMTS service, describing a second broadcast control channel [PBCCH] in the second message to at least Iu mobile stations (paragraphs 22-33), and broadcasting UMTS service information for Iu mobile stations on the second broadcast control channel (paragraph 6, 8-10, 16-18).”

However, it is respectfully pointed out that the cited paragraphs of Mildh et al. explain how the network informs an arrived mobile station to select its mode. Such a method in which, after appearing that the cell supports the UMTS service, another SI message is broadcast including a description of the (second) channel where Iu information for mobile stations is placed is not

disclosed. Thus, Mildh et al. do not disclose or suggest the claimed feature of "... describing a second broadcast control channel ..." or "... then a second broadcast control channel through which service information of the one of the two or more service modes ..." as recited in Applicant's independent claims 18 and 10, respectively.

Moreover, as noted in Applicant's prior Response, the subject application has a foreign priority date of January 10, 2002, through Swedish patent document number 20020048. The foreign priority date is prior to the filing date of March 12, 2002 of Mildh et al. Even though Mildh et al. claim priority to US provisional patent application no. 60/280,305, it is not known if the subject matter upon which the Patent Office relies in rejecting the claims also is found in this provisional patent application. Clarification is respectfully requested.

In view of the foregoing, it is asserted that Mildh et al. do not disclose or suggest Applicant's claimed invention as recited in independent claims 10 and 18. Nor is there any reason to modify the teachings of Mildh et al. in an attempt to arrive at the subject claims.

The addition of any alleged descriptions of the prior art and/or ETSI 3GPP 04.18 v 9.0 does not disclose or suggest the subject claims. In particular, the Patent Office refers to paragraph 6 of the subject application. Paragraph 6 of Applicant's specification refers to a conference publication by Ericsson Ltd. about a proposal for adding a two-bit field in the part of the message SI3. As further disclosed in this paragraph, there is only one spare bit left in the SI3 Rest Octets and there is no room for the required information in other messages sent regularly to the BCCH. This information does not cure the shortcomings of Mildh et al. and disclose or suggest the subject claims. On the contrary, Applicant's claims remove a disadvantage of other methods, as disclosed at pages 2-3 of Applicant's specification. Similarly, the addition of ETSI 3GPP 04.18 v.9.0, cited by the Patent Office for disclosing system information 13, does not disclose or suggest Applicant's claims.

Thus, independent claims 10 and 18 are believed to be allowable. Remaining claims 9, 11-15 and 19-25 also are believed to be in condition for allowance at least in view of their dependency

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from an allowable independent claim. Moreover, with specific regard to prior dependent claim (now claim 19), it is noted that the Patent Office contends that "Mildh further discloses said first channel being BCCH of the GSM system and said second channel being PBCCH of the GSM system (paragraph 19)." However, Applicant respectfully points out that paragraph 19 only mentions alternative channels for broadcasting the message with selection information. A first channel for one purpose and a second channel for another purpose are not disclosed or suggested.

In view of the foregoing, the Patent Office is requested to reconsider and remove the outstanding rejections, and favorably consider all of the pending claims as now presented for examination. A Notice of Allowance is therefore earnestly solicited.

Should the Examiner have any questions, a call to the undersigned attorney would be sincerely appreciated.

Respectfully submitted:

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